

UNITED STATES DISTRICT COURT
EASTERN DISTRICT OF TEXAS
MARSHALL DIVISION

NETLIST, INC.,

Plaintiff,

v.

SAMSUNG ELECTRONICS CO., LTD., et al.,

Defendants.

Civil No. 2:22-cv-00293-JRG
(Lead Case)

JURY TRIAL DEMANDED

NETLIST, INC.,

Plaintiff,

v.

MICRON TECHNOLOGY TEXAS, LLC, et al.,

Defendants.

Civil No. 2:22-cv-00294-JRG
(Member Case)

JURY TRIAL DEMANDED

**SAMSUNG'S SUR-REPLY TO NETLIST'S MOTION FOR SUMMARY JUDGMENT
ON SAMSUNG'S AFFIRMATIVE DEFENSE OF CLAIM PRECLUSION (DKT. 365)**



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TABLE OF EXHIBITS TO SAMSUNG'S OPPOSITION

#	Description
A	August 20, 2019, Office Action, U.S. Patent Application No. 16/391,151 (now U.S. Patent No. 10,860,506) (excerpts)
B	Terminal Disclaimer, U.S. Patent Application No. 16/391,151 (now U.S. Patent No. 10,860,506)
C	Complaint, <i>Netlist Inc. v. Samsung Elecs. Co.</i> , No. 2:21-CV-463 (E.D. Tex.) (excerpts)
D	Third Amended Complaint Against Samsung Electronics Co., Ltd., Samsung Electronics America, Inc., and Samsung Semiconductor, Inc., <i>Netlist Inc. v. Samsung Elecs. Co.</i> , No. 2:22-CV-293 (E.D. Tex.) (excerpts)
E	Plaintiff Netlist Inc.'s Second Supplemental Disclosure of Asserted Claims and Infringement Contentions (excerpts)
F	Exhibit D ('608 Patent) to Opening Expert Report of Dr. William Henry Mangione-Smith (excerpts)

TABLE OF ABBREVIATIONS

Abbreviation	Description
'506 patent	U.S. Patent No. 10,860,506
'608 patent	U.S. Patent No. 10,268,608
<i>EDTX1</i>	<i>Netlist Inc. v. Samsung Elecs. Co.</i> , No. 2:21-CV-463 (E.D. Tex)
SRNF	Samsung's Response to Netlist's Statement of Undisputed Facts (Dkt. 476 at 1)
SSMF	Samsung's Statement of Undisputed Material Facts (Dkt. 476 at 1)

Netlist does not contend that this Court dismissed the '506 patent without prejudice or that it ever moved for such relief; instead, it argues that voluntarily withdrawn claims are automatically dismissed without prejudice based on its misreading of *Sandisk Corp. v. Kingston Tech. Co.*, 695 F.3d 1348, 1353 (Fed. Cir. 2012), Dkt. 519. While *Sandisk* “**treated** [a] withdrawal of” claims as “**akin**” to dismissal, it did so only in the context of finding that there was no “reviewable” dispute. 695 F.3d at 1353-54. Whether there was a preclusive final judgment was not at issue. *Id.* In any event, Netlist neither disputes that Fifth Circuit law governs this procedural issue, nor identifies any Fifth Circuit precedent for its automatic-dismissal theory. Dkt. 519. Netlist also never disputes that Fifth Circuit precedent precludes dismissal without prejudice at such a late stage. *Compare id.*, with Dkt. 476 at 2; *In re FEMA Trailer Formaldehyde Prods. Liab. Litig.*, 628 F.3d 157, 162-63 (5th Cir. 2010); *U.S. ex rel. Doe v. Dow Chem. Co.*, 343 F.3d 325, 330 (5th Cir. 2003); *Davis v. Huskipower Outdoor Equip. Corp.*, 936 F.2d 193, 199 (5th Cir. 1991). Netlist is thus wrong that there is no final judgment on the '506 patent.

Netlist also argues that the terminal disclaimer is, standing alone, insufficient to establish preclusion, Dkt. 519, but Samsung’s evidence is not limited to the disclaimer, which remains a “strong clue” that preclusion applies. *SimpleAir, Inc. v. Google LLC*, 884 F.3d 1160, 1167-68 (Fed. Cir. 2018). Apart from the disclaimer, Samsung identified extensive factual overlap in Netlist’s factual allegations, SSMF ¶ 2, as well as the examiner’s unrebutted analysis showing that the two patents’ claims are patentably indistinct, Ex. A at 2-6, which is sufficient to “trigger claim preclusion.” *SimpleAir*, 884 F.3d at 1167. Indeed, Netlist does not deny that the examiner established that the '506 and '608 patent claims are patentably indistinct, SSMF ¶ 1, or that it accuses the same products of infringing both patents “based on substantially overlapping allegations,” *id.* ¶ 2. At a minimum, this additional evidence—which Netlist never addresses—establishes a genuine dispute of material fact as to whether its '608 and '506 patent claims involve “the same nucleus of operative facts.” *Gillig v. Nike, Inc.*, 602 F.3d 1354, 1362-63 (Fed. Cir. 2010). Hence, Netlist’s motion should be denied.

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Respectfully submitted,

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CERTIFICATE OF SERVICE

I hereby certify that a true and correct copy of the foregoing document was filed electronically in compliance with Local Rule CV-5 on February 14, 2024. As of this date, all counsel of record have consented to electronic service and are being served with a copy of this document through the Court's CM/ECF system under Local Rule CV-5(a)(3)(A) and via electronic mail.

/s/ Lauren A. Degnan

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